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769-236 Div. 2 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: McMahon et al. Examiner: John Sipos
Serial No.: 09/915,100 Art Unit: 3721
Filed: July 25, 2001
For: METHODS OF MAKING SLIDE-ZIPPERED RECLOSABLE
PACKAGES ON HORIZONTAL FORM-FILL-SEAL MACHINES

TRANSMITTAL OF APPEAL BRIEF

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Enclosed is an original brief to the Board of Patent Appeals and Interferences and three photocopies thereof. This brief is being filed pursuant to the Notice of Appeal apparently accorded an Office filing date of February 2, 2004. The Rule 17 fee for filing an appeal brief is enclosed. Any other fees may be charged to Deposit Account 50-1145, Order No. 769-236 Div. 2.

Respectfully submitted,

Gerald Levy
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Application Serial No. 09/915,100

Filed: July 25, 2001

Art Unit: 3721

Examiner: John Sipos

METHODS OF MAKING SLIDE-ZIPPERED RECLOSABLE
PACKAGES ON HORIZONTAL FORM-FILL-SEAL MACHINES

Ex parte: Michael J. McMahon
Arthur J. Malin
Steven Ausnit
David J. Matthews
Charles Thorpe

BRIEF FOR THE APPELLANTS

Pitney Hardin LLP
Attorneys for the Appellants

I. REAL PARTY IN INTEREST

The real party in interest is assignee Illinois Tool Works Inc.

II. RELATED APPEALS AND INTERFERENCES

An appeal brief for related U.S. patent application serial no. 09/631,179 is being filed substantially simultaneously herewith. On March 12, 2004, an appeal brief was filed for related U.S. application serial no. 10/208,494. Similarly, a Notice of Appeal for related U.S. application serial no. 10/301,308 has received an Office filing date of March 1, 2004.

III. STATUS OF CLAIMS

Claims 6-8 are rejected.

IV. STATUS OF AMENDMENTS

No after-final amendments were filed in response to the final Office Action of October 29, 2003. A Notice of Appeal was dated January 29, 2004, with a return postcard indicating an Office filing date of February 2, 2004.

V. SUMMARY OF INVENTION

The claimed invention of the present application relates to a method of making reclosable packages having slider-operated zippers (Fig. 7; page 7, line 22 – page 8, line 1), comprising the steps of providing a supply of a series of concatenated packages (Fig. 7, elements 16; page 8, lines 2-4), each of the packages having a reclosable zipper (Fig. 7, element 36; page 8, lines 7-8), filling each of the packages (Fig. 7, element 17; page 8, lines 4-5), providing a supply of sliders

(Fig. 7, elements 44), each of the sliders being insertable on to the reclosable zipper and adapted to open and close the reclosable zipper as the slider is moved along the reclosable zipper in opening and closing directions (page 6, lines 5-9), and, for each of said concatenated packages, after the step of filling each of the packages, removing a slider from the slider supply and inserting the slider on to the reclosable zipper (Fig. 7, element 70; page 8, lines 17-18), the closure elements of the reclosable zipper being in an interlocked configuration prior to the step of inserting the slider and remaining in the interlocked configuration during the step of inserting the slider (page 6, lines 9-11).

VI. ISSUES

1. Does the specification provide an enabling disclosure under 37 C.F.R. §1.71 and 35 U.S.C. §112, first paragraph, for claims 6-8 with respect to the interlocking members of the zipper being in an interlocked configuration prior to the step of inserting said slider and remaining in the interlocked configuration during the step of inserting the slider?
2. Are Claims 6-8 patentable under 35 U.S.C. §103 over the Herz reference (U.S. Patent No. 3,790,992) in view of the Machacek reference (U.S. Patent No. 6,047,450) or the Richardson reference (U.S. Patent No. 5,442,838) or the Herrington reference (U.S. Patent No. 5,067,208) or, alternatively, the Machacek reference, or the Richardson reference, or the Herrington reference in view of the Herz reference?

3. Are Claims 6-8 patentable under 35 U.S.C. §103 over the Herz reference in view of the Machacek reference, or the Richardson reference, or the Herrington reference and further in view of the Thomas reference (U.S. Patent No. 5,788,378) or, alternatively, the Machacek reference, or the Richardson reference, or the Herrington reference in view of the Herz reference, further in view of the Thomas reference?

4. A provisional obviousness-type double patenting issue has been deferred until the patent application has been found otherwise to be in condition for allowance.

VII. GROUPING OF CLAIMS

The claims are deemed to stand or fall together for each ground of rejection.

VIII. ARGUMENTS

1. Does the specification provide an enabling disclosure under 37 C.F.R. §1.71 and 35 U.S.C. §112, first paragraph, for claims 6-8 with respect to the interlocking members of the zipper being in an interlocked configuration prior to the step of inserting said slider and remaining in the interlocked configuration during the step of inserting the slider?

The specification of the present application states “It is preferable during slider insertion that the slider be inserted at the closing end of the zipper since the zipper is initially interlocked.” (page 6, lines 9-11, emphasis added).

The requirement of 35 U.S.C. §112, first paragraph, is that the specification be “enable” a person “skilled in the art to which [the invention] pertains, or with which it is most nearly

connected, to make and use the same.” It is respectfully submitted that the above quotation from the specification would be enabling to a person skilled in the art with respect to the cited claim language.

2. Are Claims 6-8 patentable under 35 U.S.C. §103 over the Herz reference (U.S. Patent No. 3,790,992) in view of the Machacek reference (U.S. Patent No. 6,047,450) or the Richardson reference (U.S. Patent No. 5,442,838) or the Herrington reference (U.S. Patent No. 5,067,208) or, alternatively, the Machacek reference, or the Richardson reference, or the Herrington reference in view of the Herz reference?

It is respectfully submitted that the Herz reference discloses the manufacture of an unfilled bag, where the bag is later filled, perhaps manually by the consumer. Herz never contemplated filling the bag prior to the insertion of the slider (that is, during the manufacturing process). The bag of the Herz reference was designed to be filled later by the consumer and was not intended or designed to be filled as part of the manufacturing process. There is no provision in the Herz reference for filling the bag, which would have required automatic opening and closing of the zipper by using the slider. Similarly, there is no disclosure of the step of inserting the slider *after* the filling of the bag.

It is respectfully submitted that the Machacek, Richardson and Herrington references disclose zipper and slider configurations, but there is nothing in these references or in the prior art to suggest that these zipper and slider configurations could be used with the manufacturing method of the claimed invention or that these references could be combined with the Herz reference.

It is therefore respectfully submitted that Claims 6-8 are patentable over the cited references. It is respectfully submitted that the above arguments apply regardless of whether the primary and secondary references are reversed for an alternative rejection.

3. Are Claims 6-8 patentable under 35 U.S.C. §103 over the Herz reference in view of the Machacek reference, or the Richardson reference, or the Herrington reference and further in view of the Thomas reference (U.S. Patent No. 5,788,378) or, alternatively, the Machacek reference, or the Richardson reference, or the Herrington reference in view of the Herz reference, further in view of the Thomas reference?

It is respectfully submitted that the Thomas reference discloses filling the bag in that “the top seal can be completed in a post-filling operation” (col. 6, lines 1 and 2). However, there is nothing to disclose or suggest, alone or in combination with the other cited art, the claimed “the closure elements of said reclosable zipper being in an interlocked configuration prior to said step of inserting said slider and remaining in said interlocked configuration during said step of inserting said slider”.

The Applicants respectfully traverse the Examiner’s statement on page 5 of the Office Action of October 29, 2003, “It would have been obvious to one skilled in the art to place the product of the basic references in the bag prior to placing the slider over the zipper as shown by Thomas to avoid contact of the product with the slider.” It is respectfully submitted that there is no basis for this statement, other than the wisdom of hindsight gained by the review of the present disclosure.

It is therefore respectfully submitted that Claims 6-8 are patentable over the cited references. It is respectfully submitted that the above arguments apply regardless of whether the primary and secondary references are reversed for an alternative rejection.

4. A provisional obviousness-type double patenting issue has been deferred until the patent application has been found otherwise in condition for allowance.

Terminal disclaimers will be provided, as necessary, after the application has been found otherwise to be in condition for allowance.

The Board is respectfully requested to find all of the presently pending claims to be allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald Levy", with a long horizontal flourish extending to the right.

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IX. APPENDIX OF PRESENTLY PENDING CLAIMS

Claims 1-5 (canceled)

6. The method of making packages having slider-operated zippers, said method comprising the steps of:

providing a supply of a series of concatenated packages, each of said packages having a slider-operated reclosable zipper;

filling each of said packages;

providing a supply of sliders, each of said sliders being insertable onto said reclosable zipper and adapted to open and close said reclosable zipper as said slider is moved along said reclosable zipper in opening and closing directions, respectively; and

for each of said packages, after said step of filling each of said packages, removing a slider from said slider supply and inserting said slider over said reclosable zipper at a section of said reclosable zipper, the closure elements of said reclosable zipper being in an interlocked configuration prior to said step of inserting said slider and remaining in said interlocked configuration during said step of inserting said slider.

7. The method according to claim 6 wherein said packages are connected together in a chain.

8. The method according to claim 7 including the step of cutting each of said packages from said package chain.

Claims 9-33 – (canceled)